

PATENT
Attorney Docket No.: SALK 2270-4
(088802-5211)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ronald M. Evans

Group Art Unit: 1632

Application No.: 09/840,008

Examiner: Joseph Woitach

Filing Date: April 20, 2001

CERTIFICATION OF FACSIMILE TRANSMISSION
I hereby certify that this paper is being facsimile
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For: XENOBIOTIC COMPOUND
MODULATED EXPRESSION SYSTEMS
AND USES THEREFOR

Stephen E. Reiter
Name of person mailing paper

Stephen E. Reiter
Signature

12/19/02
Date

Commissioner for Patents
Washington, D.C. 20231

RESPONSE

Sir:

Responsive to the Office Action mailed November 21, 2002 (Paper No. 12), please consider the following remarks.

REMARKS

The restriction of claims 1-26 under 35 U.S.C. 121 into two groups is respectfully traversed. Applicant respectfully requests reconsideration of the restriction requirement and examination of all currently pending claims in the same application.

A restriction requirement is proper if (1) two or more independent and distinct inventions are claimed in one application (35 U.S.C. §121), and (2) there would be a serious burden on the examiner if restriction is not required. MPEP § 803.

Applicant respectfully disagrees with the Examiner's assertion that the inventions are allegedly distinct and separate searches are allegedly required (see page 4, lines 1-11 of Paper No. 12). As acknowledged by the Examiner, the method steps required to practice the claimed

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invention are broadly the same (see page 4, line 6 of Paper No. 12). Moreover, the claims in both Groups I and II are drawn to an expression system and/or methods for the production of a target protein in a cell comprising a SXR response element and a nuclear receptor which responds to xenobiotic compounds. All expression systems embraced by the claims include the same response element, *i.e.* an SXR response element. All expression systems embraced by the claims include the same type of receptor, *i.e.* a nuclear receptor which responds to xenobiotic compounds, of which SXR and PXR are two specific examples. All methods contemplated by the claims employ cells containing the same response element, *i.e.* an SXR response element. All methods contemplated by the claims employ cells containing the same type of receptors, *i.e.*, a nuclear receptor which responds to xenobiotic compounds. Thus, the Examiner's assertion that there are allegedly no common core structure, function or process shared by each of the different receptors specifically claimed (see page 3, lines 5-6 of Paper No. 12) is clearly in error for the reasons stated above.

Moreover, most of the claims in both Groups I and II are either generic to both groups (*i.e.* claims 1, 4, 5, 6, 9, 10, 11, 14-16, 19-21 and 24) and/or linking claims (*i.e.* claims 1, 6, 11, 16, 21 and 24) which the Examiner has already acknowledged will be examined to the extent they encompass the elected invention. Furthermore, both Groups I and II are classified in the same classes and subclasses.

Therefore, because the search required for Group II will, of necessity, include the search required for Group I, there is no serious burden placed upon the Examiner by examination of all pending claims in a single application. Accordingly, Applicant respectfully requests withdrawal of the requirement for restriction and examination of all claims on the merits.

In order to be fully responsive, Applicant hereby elects Group I, claims 1, 2, 4, 5, 6, 7, 9-12, 14-17, 19-21, 24 and 25, including all the generic and/or linking claims to both Groups for examination, with traverse.

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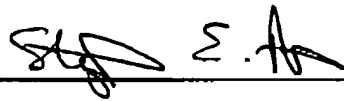
CONCLUSION

In view of the foregoing remarks, prompt and favorable action on all claims is respectfully requested. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the telephone number listed below so that a prompt disposition of this application can be achieved.

Respectfully submitted,

Date:

12/19/02



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MESSAGE:

U.S. Patent Application No. 09/840,008

Enclosures:

1. Transmittal Sheet
2. Response

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Atty. Dkt. No. SALK2270-4
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

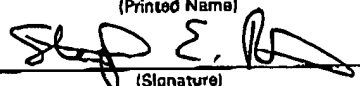
Applicant: Ronald M. Evans
Title: XENOBIOTIC COMPOUND
MODULATED EXPRESSION
SYSTEMS
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Appl. No.: 09/840,008

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Examiner: Joseph T. Woitach

Art Unit: 1632

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TRANSMITTAL SHEET

Commissioner for Patents
Box NON-FEE AMENDMENT
Washington, D.C. 20231

Sir:

Transmitted herewith is a Response for the above-identified application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

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